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Filed: 16 April 2001

For: PERFORATED FILM CONSTRUCTIONS FOR BACKLIT SIGNS

back surface of the construction is reflected." Independent claim 10 recites "a layer of reflective adhesive proximate the back surface of the construction, wherein the reflective adhesive reflects at least about 50% of normal incident light directed at the land area on the back surface of the construction."

Andriash teaches that a primary objective of the invention is to provide a vision control panel in which two images are selectively observable from one side of the panel dependent upon the intensity of light incident on the opposite side of the panel (Col. 3, lines 18-22). To accomplish this, Andriash indicates that sheet material has retroreflective material on one side and an opaque surface on the opposite side with translucent image-forming material, such as inks, overlying the retroreflective material to form the first image (Col. 2, lines 37-42). A non-perforated light-permeable material is also provided on the side of the sheet material opposite the retroreflective material, where the light-permeable material (e.g., translucent inks) are used to form the second image on the non-perforated light permeable-material (Col. 2, lines 44-51). Andriash indicates that, when using this structure, depending upon the relative intensities of light incident on the opposite side of the panel, an observer on one side of the panel sees either one or the other of the first and second images on the panel (Col. 2, lines 51-55).

Whitehead provides an image-bearing surface having a reflectivity characteristic in which a substantial portion of the image is substantially non-transmissive and substantially reflective (abstract). Whitehead further provides that the light rays that strike the reflective portion of the image-bearing surface are substantially all reflected (Abstract).

Detiker provides a plate (2) covered with at least two different superimposed layers (4) and (5), where layer (4) is made of an opaque, reflective material (Col. 3, lines 7-12). A surface of the layer (4) that faces the plate (2) should be a good optical reflector so that the rays of light meeting this surface are reflected from it and then reflected back by the mirrored rear surface (8) of the housing (1) (Col. 3, lines 48-52).

Ross provides a transparent material (26) having a mono or multi colored image on the surface of a transparent material (26) that includes a reflective surface facing the illumination

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source (Col. 46, lines 53-61). Ross indicates that the reflective surface can be used to reflect light from opaque or partially opaque sections of the material so as to maximize the reflected light in the lighting compartment (Col. 46, lines 57-61).

In rejecting claims 1-7, 9-16, 19-25 and 28, the Office Action asserts that one skilled in the art would have found it obvious "to make the adhesive or other back layer of Andriash that faces the backlit illumination source, reflective, in order to maximize the amount of light that is transmitted through the sign face surface because of the teachings of Whitehead, Detiker or Ross." Applicants respectfully traverse this assertion for at least the following reasons.

A basic tenet of *prima facie* obviousness is that a suggestion or motivation to modify the cited documents, or combine their teachings, must be identified. One intended purpose of Andriash is to provide a vision control panel in which two images are selectively observable from one side of the panel dependent upon the intensity of light incident on the opposite side of the panel. However, adding a reflective surface to the opposite side of the Andriash structure, as suggested by the Office Action, would render the structure inoperable for displaying the two images according to its intended purpose. This is because the light permeable-material used to form the second image would now have a reflective surface facing its light source. As such, this second image would not be illuminated by light from the backside as intended by Andriash, as this light would now be reflected back to its source.

"If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." M.P.E.P. 2143.01 citing In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Thus, Applicants submit that no suggestion or motivation to modify Andriash with the teachings of Whitehead, Detiker or Ross has been identified.

Furthermore, Applicants traverse any assertion that Andriash teaches or suggests a film having a reflectivity, as claimed, in combination with perforations that occupy 10% to 35% of the film surface. As noted in the specification (including examples and comparative examples), the films and backlit signs constructed with the films provide measurable advantages in brightness

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over conventional designs. Those advantages are provided by the combination of back surface reflectivity and the amount of area occupied by the perforations in the films. These advantages are discussed, for example, at page 7, lines 14-31. As a result, the disclosure of perforations occupying 10% to 68% of the area of the films in Andriash cannot, without more, be relied on as the basis for a *prima facie* obviousness rejection of claims 1-7, 9-16, 19-25 and 28.

Dependent claims 2-7, 9, 12-16, 19, 21-25 and 28 are also submitted to be patentable not only in view of their dependence, but also in view of the subject matter recited therein.

Based on the foregoing, Applicants respectfully submit that the Office Action fails to establish a *prima facie* case of obviousness for the rejection of claims 1-7, 9-16, 19-25 and 28. Accordingly, Applicants request reconsideration and withdrawal of the rejection.

Claims 8, 17-18 and 26-27

The Office Action also rejected claims 8, 17-18 and 26-27 under 35 U.S.C. §103(a) as being unpatentable over Andriash as modified in claims 1-7, 9-16, 19-25 and 28 above, and further in view of U.S. Patent No. 5,954,423 to Logan et al. (hereinafter "Logan"). Applicants respectfully traverse the rejection of these claims for at least the following reasons.

No motivation to combine Andriash with Ross, Detiker or Whitehead has been identified as discussed above with respect to the rejection of claims 1, 11 and 20, from which claims 8, 17-18 and 26-27 depend, respectively. Moreover, Applicants submit that the cited documents fail to teach or suggest all the elements of claims 8, 17-18 and 26-27. For example, no teaching or suggestion is identified within the cited documents of a color layer comprising a black polymeric film attached to a white intermediate layer, as recited in claim 8. In addition, a color layer comprising a black film attached to a white intermediate layer, as recited in claims 18 and 27, is not identified. Rather, Logan recites that an interior wall surface of an exit sign can be coated with a reflective material such as white paint (Col. 7, lines 1-9). However, no teaching is identified in Logan that the wall coated with the white paint includes either a black film, or a black polymeric film, as recited in claims 8, 18 and 27.

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Based on the foregoing, Applicants respectfully submit that the Office Action fails to establish a *prima facie* case of obviousness for the rejection of claims 8, 17-18 and 26-27. Applicants request reconsideration and allowance of these claims.

Summary

It is respectfully submitted that the pending claims 1-28 are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for
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13 May 2003
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CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that this paper is being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Assistant Commissioner for Patents, Washington, D.C. 20231, on this 13th day of May, 2003, at 6:20 PM (Central Time).

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